

UNITED STATES PATENT AND TRADEMARK OFFICE



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Vignin 22313-1450 www.uspto.gov

PPLICATION NO.	FI	ILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
09/893,244	06/27/2001		Barry S. Fogel	0264724-0031	4907
24280	7590	09/08/2003			
Choate, Ha		art	EXAMINER		
Exchange Place 53 State Street			CRIARES, THEODORE J		
Boston, MA 02109		•	ART UNIT	PAPER NUMBER	
				1617	10
				DATE MAILED: 09/08/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 07-01)

-..

	Application No.	Applicant(s)				
	09/893,244	FOGEL, BARRY S.				
Office Action Summary	Examiner	Art Unit				
	Theodore J. Criares	1617				
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply						
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). Status						
1) Responsive to communication(s) filed on 0	95 August 2003 .					
2a) ☐ This action is FINAL . 2b) ☑	This action is non-final.					
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213. Disposition of Claims						
4)⊠ Claim(s) <u>1-62 and 81-99</u> is/are pending in t	he application.					
4a) Of the above claim(s) <u>1-62</u> is/are withdrawn from consideration.						
5) Claim(s) is/are allowed.						
6) ☐ Claim(s) is/are rejected.						
7) Claim(s) is/are objected to.						
8) Claim(s) 81-88 are subject to restriction and/or election requirement.						
Application Papers						
9) The specification is objected to by the Examiner.						
10) The drawing(s) filed on is/are: a) □ accepted or b) □ objected to by the Examiner.						
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).						
11)☐ The proposed drawing correction filed on is: a)☐ approved b)☐ disapproved by the Examiner.						
If approved, corrected drawings are required in reply to this Office action.						
12)☐ The oath or declaration is objected to by the Examiner.						
Priority under 35 U.S.C. §§ 119 and 120						
13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).						
a) ☐ All b) ☐ Some * c) ☐ None of:						
1.☐ Certified copies of the priority docume	ents have been received.					
2. Certified copies of the priority documents have been received in Application No						
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 						
	•					
14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).						
a) ☐ The translation of the foreign language provisional application has been received. 15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.						
Attachment(s)						
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s	5) 🔲 Notice of Informal	ry (PTO-413) Paper No(s) · Patent Application (PTO-152)				
U.S. Patent and Trademark Office PTOL-326 (Rev. 04-01) Office	Action Summary	Part of Paper No. 10				

Application/Control Number: 09/893,244

Art Unit: 1617

CLAIMS 1-62 AND 81-88 ARE PRESENTED FOR EXAMINATION

DETAILED ACTION

Applicant's election of Group II, claims 81-88, in Paper No. 8 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Further restriction is required.

Election/Restrictions

Claim 81 is generic to a plurality of disclosed patentably distinct species comprising various synergistic compositions of corticosteroids and N-substituted benzamide compounds as set forth in claims 1-16 and 20-29 (Group I) and claims 17-19 (Group II). Should applicant elect Group II a combination of an enhancing GABA-A neurotransmission agent and a decreasing NMDA-type glutamate neurotransmission agent.

Examination will be performed as to the elected combination since at page 13, lines 14-18 of the specification applicant teaches that the invention relates to a synergistic combination since the claimed combination prolons the duraton of action of a dose of the mixture.

Application/Control Number: 09/893,244

Art Unit: 1617

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of each agent, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theodore J. Criares whose telephone number is 308-4607. The examiner can normally be reached on 6:30 A.M. to 5:00P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1235.

Theodore J. Criares

Application/Control Number: 09/893,244

Art Unit: 1617

Primary Examiner Art Unit 1617

tjc September 2, 2003